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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/664,383 | 09/18/2000 | Tomohiro Gomi | 35.C14803 | 4743 |
| 5514 | 7590 | 01/06/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO | | | PHAM, THIERRY L | |
| 30 ROCKEFELLER PLAZA | | | ART UNIT | |
| NEW YORK, NY 10112 | | | PAPER NUMBER | |

2624

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/664,383 | GOMI, TOMOHIRO | |
| | Examiner | Art Unit | |
| | Thierry L Pham | 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-11,13-15,17,18,20-25,27-29,31,32,34-39,41-43,45,46,48-53,55 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,3,4,6-11,13-15,17,18,20-25,27-29,31,32,34-39,41-43,45,46,48-53,55 and 56.

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DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 9/7/04.
- Claims 2, 5, 12, 16, 19, 26, 30, 33, 40, 44, 47, and 54 have been canceled.
- Claims 1, 3-4, 6, 7-11, 13-15, 17-18, 20-25, 27-29, 31-32, 34-39, 41-43, 45-46, 48-53, 55-56 are pending in application.
- Objection to title has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7, 15, 21, 29, 35, 43, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to disclose any descriptions regarding “determining whether the owner of the print job is identical to a user of the information processor” and notification means for displaying a message that the instructed print job has not been interrupt printed if said detection means “determines that the owner of the print job is identical to the user of said information processor”. In other words, the originally filed specification does not provide any adequate written description indicating the print job *has not been interrupt printed* due to the comparison results based upon the *owner’s ID of the print job and owner’s ID of the host computer*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 6, 15, 17-18, 20, 29, 31-32, 34, 43, 45-46, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauronski et al (U.S. 5206735), and in view of Ban (U.S. 6332170).

Regarding claim 1, Gauronski discloses an information processor (scanner/controller, fig. 2) which can communicate with a printer (printer, fig. 2), comprising:

- generation means (scanner, fig. 2) for generating a print job (image files/print jobs, col. 3, lines 55-67 and col. 5, lines 18-50) to be processed by said printer;
- instruction means (interrupt instructions for job interrupts, col. 6, lines 18-55 and col. 7, lines 4-22) for instructing any of the print jobs generated by said generation means to be interrupt printed by the printer;
- detection means (controller, fig. 2) for receiving information from the printer indicating that interrupt printing of the print job instructed by said instruction means has failed (the interrupt job cannot be performed because parameters of interrupt print job are not available at the printer, col. 7, lines 29-36);
- notification means (display messages via user interface/display unit, figs. 1 & 5B, col. 7, lines 29-38) for causing the user that the instructed print job not been interrupt printed (a message indicates the interrupt jobs cannot be performed because parameters of interrupt print job are not available at the printer, col. 7, lines 29-36).

However, Gauronski fails to explicitly disclose a detection means for detecting information indicating an owner of the print job, and for determining/detecting whether the owner of the print job is identical to a user of said information processor.

Ban, in the same field of endeavor for interrupt printing, teaches a detection means for detecting information indicating an owner of the print job, and for determining/detecting whether

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the owner of the print job is identical to a user of said information processor (host computers 41-44 for receiving information indicating a plurality of print jobs with corresponding user's name and interrupt print jobs, fig. 11, col. 4, lines 20-52 and col. 5, lines 40-56, and obviously, a user who submits a print job is also an owner of both the print job and host computer, a comparison is not necessary).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Gauronski as per teachings of Ban by adding a owner's name to the print job because of a following reason: (●) to distinguish a print job from a plurality of print jobs by viewing user's name and/or document's name.

Therefore, it would have been obvious to combine Gauronski with Ban to obtain the invention as specified in claim 1.

NOTE: The newly added limitations raise new issues and the originally filed specification does not provide any adequate written description regarding the newly added limitations, please see 112, first paragraph above for more details. Also, newly added limitations prohibit/prevent a user/owner from submitting an interrupt print request, which teaches away from the originally filed specification.

Regarding claim 3, Gauronski further discloses the processor according to claim 2, wherein said notification means causes said display unit to display an icon (col. 4, lines 5-16 and col. 7, lines 29-38) indicating that said print job has not been interrupt printed.

Regarding claim 4, Gauronski further discloses the processor according to claim 1, wherein said detection means receives from said printer some information (a message indicates interrupt job is prohibited because lack of available parameters at the printer, col. 7, lines 29-38) indicating that said print job instructed by said instruction means to be interrupt printed has not been interrupt printed.

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Regarding claim 6, Gauronski further discloses the processor according to claim 1, wherein said notification means notifies the user that said print job has not been interrupt printed but normally printed (interrupt job resumes, col. 6, lines 18-27 and col. 7, lines 4-60).

Regarding claims 15, 17-18, 20: Claims 15, 17-18, 20 are the method claims corresponding to the apparatus claims 1, 3-4, 6 (respectively). The methods are inherent and included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claims 1, 3-4, 6 above.

Regarding claims 29, 31-32, 34: Claims 29, 31-32, 34 correspond to claims 1, 3-4, 6 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (RAM, fig. 5B) for storing computer programs, hence claims 29, 31-32, 34 would be rejected using the same rationale as in claims 1, 3-4, 6.

Regarding claims 43, 45-46, 48: Claims 43, 45-46, 48 correspond to claims 1, 3-4, 6 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (RAM, fig. 5B) for storing computer programs, hence claims 43, 45-46, 48 would be rejected using the same rationale as in claims 1, 3-4, 6.

1. Claims 7, 9-14, 21, 23-28, 35, 37-42, 49, and 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al (U.S. 6130757) and in view of Ban (U.S. 6332170), and

Regarding claim 7, Yoshida discloses a print controller (server apparatus/managing unit, col. 3, lines 1-17 and Abstract) which can process print jobs from a plurality of information processors (clients connecting via LAN network, col. 4, lines 17-30), comprising:

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- interrupt means (print jobs with higher priority, abstract, col. 3, lines 1-17 and col. 18, lines 6-47) for suspending print operation for a print job and executing an interrupt print of another print job according to an instruction for interrupt print;
- determination means (CPU 103 of server apparatus, col. 18, lines 6-47) for determining whether said interrupt print is being executed by said interrupt means; and
- decision means (CPU 103 of server apparatus, col. 18, lines 15-47) for, in response to reception of an interrupt-instructed print job, deciding (CPU 103 decides the priority of print job received from the clients, cols. 17-18) whether a received print job is interrupt printed (CPU 103 determines whether the interrupt job is printed or not, col. 18, lines 7-27), based on the determination result from said determination means.
- transferring means for transferring (communication lines 7, fig. 1), to the one information processor, information indicating that the interrupt printing of the received print job has failed (processes and prints the current job if the interrupt job is not possible, col. 18, lines 13-20), wherein the one information processor (clients connecting via LAN network, col. 4, lines 17-30), causes a display unit to display that the print job has not been interrupt printed.

However, Yoshida fails to explicitly disclose a decision means for detecting information indicating an owner of the print job, and for determining/deciding whether the owner of the print job is identical to a user of said information processor.

Ban, in the same field of endeavor for interrupt printing, teaches a detection means for detecting information indicating an owner of the print job, and for determining/detecting whether the owner of the print job is identical to a user of said information processor (host computers 41-44 for receiving information indicating a plurality of print jobs with corresponding user's name and interrupt print jobs, fig. 11, col. 4, lines 20-52 and col. 5, lines 40-56, and obviously, a user who submits a print job is also an owner of both the print job and host computer, a comparison is not necessary).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Yoshida as per teachings of Ban by adding a owner's name to the print job because of a following reason: (●) to distinguish a print job from a plurality of print jobs by viewing user's name and/or document's name.

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Therefore, it would have been obvious to combine Yoshida with Ban to obtain the invention as specified in claim 1.

NOTE: The newly added limitations raise new issues and the originally filed specification does not provide any adequate written description regarding the newly added limitations, please see 112, first paragraph above for more details. Also, newly added limitations prohibit/prevent a user/owner from submitting an interrupt print request, which teaches away from the originally filed specification.

Regarding claim 9, Yoshida further discloses the controller according to claim 7, wherein execution of multiple interrupts (multiple interrupts, figs. 10-11, col. 19, lines 34-39) means that an interrupt print is further executed while a previous interrupt print is being executed by said interrupt means (interrupt prints with highest priority are being printed first, col. 18, lines 7-47).

Regarding claim 10, Yoshida further discloses the controller according to claim 7, wherein said print controller is a print controller for said printer (copy machines with printing function are connecting with server apparatus via LAN network, fig. 1, col. 4, lines 16-51 and col. 18, lines 8-47).

Regarding claim 11, Yoshida further discloses the controller according to claim 7, wherein said print controller is a print controller for a device having a copy function (copy machine connects with server apparatus via LAN network, fig. 1, col. 4, lines 16-51 and col. 18, lines 8-47).

Regarding claim 13, Yoshida further discloses the controller according to claim 7, wherein a received print job is processed in normal order if it is decided that said received print job is not interrupt printed (continues to process and print the current job if the interrupt job is not possible, col. 18, lines 13-20).

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Regarding claim 14, Yoshida further discloses the controller according to claim 13, further comprising transfer means for transferring to an information processor some information (printing statuses, figs. 10-11, col. 11, lines 10-46) indicating that a received print job is processed in normal order (processes and prints the current job if the interrupt job is not possible, col. 18, lines 13-20) if it is decided that said received print job is not interrupt printed.

Regarding claims 21, 23-25, 27-28: Claims 21, 23-25, 27-28 are the method claims corresponding to the apparatus claims 7, 9-11, 13-14 (respectively). The methods are inherent and included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claims 7, 9-11, 13-14 above.

Regarding claims 35, 37-39, 41-42: Claims 35, 37-39, 41-42 correspond to claims 7, 9-11, 13-14 (respectively) except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (RAM, fig. 4) for storing computer programs, hence claims 35, 37-39, 41-42 would be rejected using the same rationale as in claims 7, 9-11, 13-14.

Regarding claims 49, and 51-53, 55-56: Claims 49, and 51-53, 55-56 correspond to claims 7, 9-11, 13-14 (respectively) except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (RAM, fig. 4) for storing computer programs, hence claims 49, and 51-56 would be rejected using the same rationale as in claims 7, 9-11, 13-14.

2. Claims 8, 22, 36, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida and Ban as described in claims 7, 21, 35, and/or 49 above, and further in view of Gauronski (U.S. 5206735).

Regarding claim 8, Yoshida and Ban do not explicitly disclose a controller further comprising prohibition means for prohibiting multiple interrupts, wherein said decision means

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decides that a received print job is not interrupted print if multiple interrupts are prohibited by said prohibition means.

Gauronski, in the same field of endeavor for interrupt prints, teaches a controller further comprising prohibition means for prohibiting multiple interrupts (multiple interrupts are prohibited/restricted, col. 7, lines 38-60), wherein said decision means decides that a received print job is not interrupted print (the next interrupt print job is restricted such that it will be placed in print queue immediately after the previously programmed interrupt job, col. 7, lines 38-67) if multiple interrupts are prohibited by said prohibition means.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Yoshida and Ban as per teachings of Gauronski because of a following reason: (1) allowing the first interrupt job to be completed before printing the next interrupt job; therefore, improving operating efficiency of the interrupt printing system.

Therefore, it would have been obvious to combine Yoshida and Ban with Gauronski to obtain the invention as specified in claim 8.

Regarding claim 22: Claim 22 is the method claim corresponding to the apparatus claim 8. The methods are inherent and included by the operation of the apparatus. Please see claims rejection basis/rationale as described in claim 8 above.

Regarding claims 36 and 50: Both claims 36 and 50 correspond to claim 8 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (Yoshida, RAM, fig. 4) for storing computer programs, hence claims 36 and 50 would be rejected using the same rationale as in claim 8.

Response to Arguments

Applicant's arguments filed on 9/7/04 have been fully considered but they are not persuasive.

- Regarding claims 1, 15, 29, and 43, the applicant argued the cited prior art (U.S. 5206735 by Gauronski) does not teach and/or suggest an information indicating that interrupt printing of an

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instructed print job has failed and information indicating the owner of the print job, and determines whether the owner of the print job is identical to the user of information processor or a display unit to display that the instructed print job has not been interrupted printed, if the owner of the print job is identical to the user of the information processor.

In response: The applicant argued subject matter which was not cited in previous claims 1, 15, 29, and 43. In addition, an originally filed specification does not provide any adequate support for newly added limitations “an information indicating that interrupt printing of an instructed print job has failed and information indicating the owner of the print job, and determines whether the owner of the print job is identical to the user of information processor or a display unit to display that the instructed print job has not been interrupted printed, if the owner of the print job is identical to the user of the information processor”, which raises new matters. In addition, the newly added limitations prohibit/prevent the owner of the print job from submitting an interrupt print requests, which teaches away from the applicant’s invention/disclosure.

- Regarding claims 7, 21, 35, and 49, the applicant argued the cited prior art does not teach and/or suggest an information indicating that the interrupt printing of the received print job has failed and information indicating the owner of the print job, if the print job is not to be interrupted printed. The information processor causes a display unit to display that the print job has not been interrupt printed, if the owner of the print job is identical to the user of the information processor.

- In response: The applicant argued subject matter which was not cited in previous claims 7, 21, 35 and 49. In addition, an originally filed specification does not provide any adequate support for newly added limitations “an information indicating that the interrupt printing of the received print job has failed and information indicating the owner of the print job, if the print job is not to be interrupted printed. The information processor causes a display unit to display that the print job has not been interrupt printed, if the owner of the print job is identical to the user of the information processor”. In addition, the newly added limitations prohibit/prevent the owner of the print job from submitting an interrupt print requests, which teaches away from the applicant’s invention/disclosure.

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Please Note: Obviously, the owner of the print job and user of the information processor is identical, since the owner is using the information processor to submit the print job, which created by the same owner. The newly added limitations clearly prevent/prohibit the owner of submitted print jobs from requesting an interrupt print, which contradicts with the applicant's originally filed specification.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

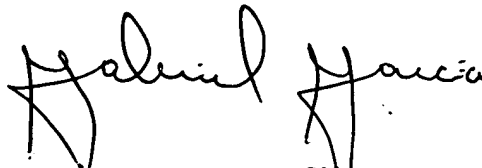
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER